

Figs. 18 and 19, and referring to column 23, lines 48 through 68 and to column 24, lines 1 through 68. This rejection is traversed.

There is no admission that the problem addressed and solved by the claimed invention is prior art.

The Examiner's primary reference is the semiconductor device depicted in Figs. 15 through 17. Figs. 15 and 17 represent a prior art **device**. However, the **problem** illustrated therein was **not** intended to be an admission that such problem was recognized in the prior art. Rather, the discussion of that problem appearing in the paragraph bridging pages 1 and 2 of the written description of the specification, and the illustration of that problem, represents Applicants' discovery of the problem.

Again, Applicants discussion of the **problem** illustrated in the conventional **device** depicted in Figs. 15 through 17 represents Applicants' discovery of the problem. It was not intended as an admission of prior art recognition of the that problem. The Examiner is not free to coerce an admission of prior art out of Applicants where no such admission was intended. *Aktiebolaget Karlstads Mekaniska Werkstad v. United States International Trade Commission*, 705 F.2d 1565, 217 USPQ 865 (Fed. Cir. 1983).

There is no Motivation

As previously argued in the Amendment submitted November 13, 2002, in order to establish the requisite motivation, the Examiner must make a "thorough and searching" factual inquiry and, based upon that factual inquiry, explain **why** one having ordinary skill in the art would have been realistically impelled to modify particular prior art, in this

case, the acknowledged prior art device, to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Indeed, as held by the Honorable Court of Appeals for the Federal Circuit in *Teleflex Inc. v. Ficosa North America Corp.*, ___ F.3d ___, 63 USPQ2d 1374, 1387 (Fed. Cir. 2002):

The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.

It should be apparent that the Examiner has not established the requisite factual basis to support the asserted reason to modify the acknowledged prior art device. As pointed out above, the only reason offered by the Examiner is the acknowledged prior art device. However, as clarified above, Applicants did **not** admit that the problem of void formation 109 which is filled in with polysilicon thereby short circuiting neighboring polypads 104a and 104b (Fig. 17) was known in the art. Rather, the illustration denotes Applicants' recognition of the problem.

As the Examiner has **not** provided any **factual** basis to establish that one having ordinary skill in the art would have been aware of the particular short circuiting problem illustrated in Fig. 17, there is **no factual basis** upon which to predicate the conclusion that one having ordinary skill in the art would have been realistically motivated to modify the acknowledged prior art device in any particular manner, let alone by applying the technique of Saitoo et al. to the acknowledged prior art. There must be a reason to modify the applied prior art and that reason must stem from a factual basis. *Teleflex Inc. v. Ficosa North America Corp.*, *supra*; *In re Lee*, *supra*. No such factual basis has been established.

Applicants, therefore, submit that the Examiner did not establish a *prima facie* basis to deny patentability to the claimed invention for lack of the requisite realistic motivation. Moreover, there is a potent indicium of **nonobviousness** which must be given consideration. Specifically, Applicants discovered that a void 109 occurs in the region 109a, shown in Fig. 17, and that polysilicon enters the void at the time of depositing polysilicon for making a polypad, thereby causing short-circuiting between neighboring polypads 104a and 104b, as illustrated in Fig. 17. Applicants' discovery of this problem is, in itself, an indicium of **nonobviousness**. *In re Sponnoble*, 405 F.2d 578, 160 USPQ 237 (CCPA 1969).

Conclusion

Applicants, therefore, submit that the Examiner did not establish a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. §103 for lack of the requisite realistic motivation. Moreover, upon giving due consideration to the problem discovered by Applicants, the conclusion appears inescapable that one having ordinary skill in the art would **not** have found the claimed invention **as a whole** obvious within the meaning of 35 U.S.C. §103. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

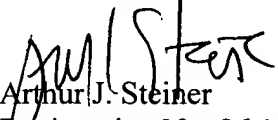
Applicants, therefore, submit that the imposed rejection of claims 7 through 11 under 35 U.S.C. §103 for obviousness predicated upon the acknowledged prior art (Figs. 15 through 17) in view of Saitou et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

09/915,567

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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